

III. Remarks

Responsive to the outstanding Examiner's Action, the applicant has carefully studied the Examiner's comments. Favorable reconsideration of this application is respectfully requested in light of the following detailed discussion.

Claims 1, 3-8, 10-19 and 21 are pending in the application. Claims 1, 3-8, 10-19 and 21 are rejected. Claim 2, 4, 9, 10, 20 and 21 are canceled. Claims 13-18 are withdrawn. Claims 1, 7 and 11 have been amended. A listing of the pending claims, along with a status indicator of each claim, appears above.

Claims 1, 3-9, 11, 12 and 20 were previously rejected under 35 USC 102(b) as being anticipated by JP 05180005. This same rejection was included in the present Office Action. The present Office Action also rejected claim 1, 3-8, 11 and 12 (claims 9 and 20 being cancelled) under 35 USC 102(b) as being anticipated by JP05180005.

According to the MPEP, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See MPEP 2131 (quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631) (emphasis added).

Independent claims 1 and 7 now both require that at least a portion of the retention sleeve extends at least partially into an aperture formed in a cylinder head and a portion of the retention sleeve extends through an aperture in a valve cover. JP 05180005 is completely silent regarding any these requirements.

Independent claim 1 further now requires a retention sleeve, having a radially outwardly projecting head flange beneath and in direct contact with the head portion, disposed about the threaded fastener. The Examiner designated item 10b as the retention sleeve and 10e the

threaded fastener, thus with the intervening structure comprising at least elements 10a, 10c and 10d, JP 05180005 does not teach this limitation.

Independent claim 1 also now requires that the valve cover is located above the cylinder head so that the wave spring is above and in direct contact with the cover. As previously mentioned JP 05180005 is silent regarding either a cylinder head or a valve cover, thus it also cannot teach the foregoing limitations regarding a cylinder head or valve cover.

Independent claim 7 now requires that the retention sleeve is disposed about at least a portion of the fastener, wherein the retention sleeve includes a flange section located directly below and in direct contact with the head portion of the fastener. Again, based on the Examiner's definition of components described above, JP 05180005 does not teach such a structure.

Independent claim 7 also now requires a wave spring disposed about at least a portion of the retention sleeve; wherein the fastening system acoustically decouples valve cover and the cylinder head while generally maintaining a seal therebetween and wherein said wave spring is directly bounded between said valve cover and said retention sleeve flange section. JP 05180005 does not teach a wave spring directly bounded between a valve cover and a retention sleeve flange section as part 10a is located between 10b and 10c.

Since JP 05180005 fails to teach each and every limitation of either independent claim 1 or 7 as now amended, it is respectfully submitted that independent claims 1 and 7 are patentable over JP 05180005.

Claims 1, 3, 4, 6-9, 11, 12 and 20 were previously rejected under 35 USC 102(b) as being anticipated by, or under 35 USC 103(a) as being obvious over JP 11050842. This same rejection was included in the present Office Action. In the present Office Action, the Examiner also

rejected claims 1, 3, 4, 6-8, 11 and 12 (claims 9 and 20 being cancelled) under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over JP11050842.

The standard for rejecting claims under 35 USC 102(b) is provided above. According to the MPEP, “[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.” See MPEP 2143 (emphasis added).

Independent claims 1 and 7 now both require that at least a portion of the retention sleeve extends at least partially into an aperture formed in a cylinder head and a portion of the retention sleeve extends through an aperture in a valve cover. JP 11050842 is completely silent regarding these requirements and in particular a valve cover and/or cylinder head.

Independent claim 1 further now requires a retention sleeve, having a radially outwardly projecting head flange beneath and in direct contact with the head portion, disposed about the threaded fastener. The Examiner designated item 3b as the head flange, thus with this designation JP11050842 does not teach this limitation.

Independent claim 1 also now requires a wave spring disposed about the retention sleeve and in direct contact with an underside of said head flange. The Examiner designated item 6 as the wave spring in JP11050842, thus with this designation the references does not teach this requirement.

Independent claim 1 also now requires that the valve cover is located above the cylinder head so that the wave spring is above and in direct contact with the cover. As previously mentioned JP11050842 is silent regarding either a cylinder head or a valve cover, thus it also cannot teach the foregoing limitations regarding a cylinder head or valve cover.

Independent claim 7 now requires that the retention sleeve is disposed about at least a portion of the fastener, wherein the retention sleeve includes a flange section located directly below and in direct contact with the head portion of the fastener. Again, since the Examiner designated item 3b as the head flange of the retention sleeve 3, JP11050842 does not teach such a structure.

Since JP11050842 fails to teach each and every limitation as required by 35 USC 102(b) of either independent claim 1 or 7 as now amended, and since the cited art fails to teach or suggest the limitations of amended claims 1 and 7 as required by 35 USC 103(a), it is respectfully submitted that independent claims 1 and 7 are patentable over JP11050842.

The Examiner rejected claims 1, 3-8, 10-12, 19 and 21 under 35 USC 112, second paragraph. The claims have been amended to overcome this rejection.

In light of the above discussion and the amendments to claims 1 and 7, amended claims 1 and 7 of the present invention are patentable. Furthermore, claims 3, 5-6, 8, 11, 12 and 19 each depend on claims 1 or 7, either directly or indirectly, and contain all of the limitations thereof. Therefore, because claims 1 and 7 are patentable and claims 3, 5-6, 8, 11, 12 and 19 each depend on claims 1 and 7, claims 3, 5-6, 8, 11, 12 and 19 are patentable over the cited references.

In light of the remarks above, it is believed the claims are now in condition for allowance and an early Notice of Allowance is respectfully requested.

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Should the Examiner wish to modify any of the language of the claims, applicant's attorney suggests a telephone interview in order to expedite the prosecution of the application.

Respectfully submitted,



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